

## REMARKS

In view of the preceding amendments and the comments which follow, and pursuant to 37 C.F.R. § 1.111, amendment and reconsideration of the Official Action of June 6, 2003 is respectfully requested by Applicant.

### Summary

Claims 1 – 67 stand rejected. Claims 12, 13, 15, 18, 19, 25, 26, 33, 34, 39, 40, 42 – 45, 47, 48, 53, 58, 59, 61, and 64 – 66 have been cancelled. Claims 1, 20, 23, 24, 30, 46, 50, and 54 are amended. No new matter has been introduced as a result of these amendments. Original and amended claims provided in the Listing of Claims section are pending following entry of the present amendments, and remarks.

### Rejection under 35 U.S.C. § 103(a)

The Examiner has rejected claims 1-5, 7-9, 14, 16-17, 20-21, 23-26, 28-29, 30-31, 33-35, 41, 46-56, 60 and 62-63 and 2 under 35 U.S.C. 103(a), as being unpatentable over Ryan (U.S. Patent 6,064,993) and further in view of Harvey et al. (U.S. Patent 6,026,385).

In this rejection, the Examiner has combined Ryan's patent, which relates to a remote control of the printer, with Harvey's patent, which relates to a printing of an image file as indicia. However, claim 1 now recites that a request for printing is submitted from consumer's computer, establishing a second communication connection from said provider to a consumer printer, and transmitting by said provider an electronic certificate data at least partially contained within an image file to said consumer's printer as the provider directly transmits the file of the image of an electronic certificate to the user's printer (see page 8, line 28 to page 9, line 10). As claim 1 recites, the claimed method includes the step of "controlling a printing of an electronic certificate by the provider." The printing is in effect controlled by the provider's printer driver, either directly through a network or via a consumer's computer, by

communicating directly with the printer's driver that resides in the consumer's printer. This printing control helps reduce the possibility for altering or forging the electronic certificate. This is in contrast to the prior art that teaches controlling the printer for an electronic certificate by the user's computer.

Further, although Harvey teaches the printing of indicia data including the image, Harvey does not teach transmitting the image file directly to the user's printer from the provider. In fact, Harvey states "Control unit 36 which contains a microprocessor, memory means and non-volatile storage controls all machine operations, including communication with the Data Center, user interface and printing functions" (column 4, lines 32-35).

In addition, because the provider transmits the image file to the user's printer, the data being transmitted to the user's printer becomes complex. Hence, any altering or forging of the electronic certificates become more difficult to the user. Therefore a request for printing is submitted from a consumer's computer, and a printing of an electronic certificate on said consumer's printer is controlled by the provider are not taught by Ryan and Harvey, either singly or in combination with each other. Applicant therefore respectfully requests that the rejections of claim 1 under 35 U.S.C. § 103(a) be withdrawn.

Applicant has also amended claims 20, 23, 30, 54 in a similar manner to claim 1 to include the limitation where the possibility of altering or forging the electronic certificates is reduced. So as in claim 1, these amendments prevent claims 20, 23, 30 and 54 from being teachable by Ryan or Harvey, either singly or in combination with each other. Thus, Applicant respectfully requests that the rejections of claim 20, 23, 30 and 54 under 35 U.S.C. § 103(a) be withdrawn.

Claims 7 – 9, and 28 – 29 dependent on claims 1 or 23, shown above to be allowable, are also allowable. Similarly for claims 14 and 60 which are dependent on allowable claims 1 or 54, and claims 16, 17, 41 and 62 – 63 which are dependent on allowable claims 1, 30, or 54.

The Examiner has further rejected claims 6, 10, 11 – 13, 15 – 19, 22, 27, 38 – 40, 42- 45, 57 – 59, 61, and 64 - 65 under 35 U.S.C. 103(a), as being unpatentable over Ryan and further in view of Harvey et al. Applicant has amended claims 6, 22 and 27 to recite that the provider confirms that the printer has sufficient supplies and that it is connected to the network (see page 8, lines 20 – 23). Thus, in the present invention, not only is the confirmation of supplies confirmed, but so is the printer's connection through the network. So at the request of a computer consumer, the provider controls the printer directly as needed. However in the Ryan patent, a confirmation as to which the printer is connected to the network is not performed. Thus, claims 6, 22 and 27 are not taught by Ryan or Harvey, either singly or in combination with each other, and Applicant respectfully requests that the rejections of claim claims 6, 22 and 27 under 35 U.S.C. § 103(a) be withdrawn. The remaining above listed claims which are dependent on 6, 22, and 27 are therefore also allowable.

Applicant has further amended claims 11, 29, 38, and 57 to include a limitation found in the specification that refers to a cutter (see page 10, lines 11 – 13). This limitation refers to the printer having a cutter for printing various electronic certificates in their usual and customary dimensions.

The Examiner has next rejected claims 32, 36 – 37 under 35 U.S.C. 103(a), as being unpatentable over Ryan and Harvey, and in further view of Golden et al. (U.S. Patent 5,761,648). Claim 32 has been amended to recite that the printing device includes means for canceling a printed image material and means for sending information about the cancellation. Golden teaches canceling a coupon on the system (deleting coupons from the system). However, Golden does not teach canceling the electronic certificate data on which the image is printed. Further, in the present invention a user's printer can reimburse the printed electronic certificates data by canceling (see page 10, lines 20 to 32). Thus the cancellation and the repayment are done in the user's printer. Hence Ryan, Harvey and Golden do not render claim 32 unpatentable,

either singly or in combination with each other, and Applicant respectfully requests that the rejections of claim 32 under 35 U.S.C. § 103(a) be withdrawn.

Claims 36 and 37 have been amended, and claim 37 is now dependent on claim 36. Claim 36 now recites that a scanning of an image of a printed material can be in defaced form before it is sent to a remote provider. Thus the feature of claim 32 is to have the deface means, the image scanning means and the transmission means in the printer to cancel the certificates which have been printed (see page 10, lines 20 to 32).

Since claims 36 and 37 are dependent on allowable claim 32, thus they are also allowable. Applicant respectfully requests that the rejections of claim 36 and 37 under 35 U.S.C. § 103(a) be withdrawn.

The Examiner has further rejected claims 66 and 67 under 35 USC 103(a) as being unpatentable over Ryan in view of Harvey and further in view of Official Notice. Applicant has cancelled claim 66 and amended claim 67. Claim 67 now recites that "the transmitting acts include transmitting said first and second electronic certificate data to an intermediary printer maintenance organization and said intermediary printer maintenance organization regularly check the consumer printer supplies", (see page 13, lines 13 to 16). Hence, when the intermediary party is an intermediary printer maintenance organization, a maintenance organization confirms the user's printer supply goods and the amount of appropriate supply goods to the end user if there were two or more providers. This limitation is not taught by Ryan, Harvey or the Official Notice, either singly or in any combination with the other two, and since claim 67 is dependent on allowable claim 54, Applicant therefore respectfully requests that the rejections of claim 67 under 35 U.S.C. § 103(a) be withdrawn.

### **Conclusion**

Applicant submits that this application is now in condition for allowance, and favorable reconsideration of this application in view of the above

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amendments and remarks is respectfully requested. Applicant believes a one month extension is due with respect to the present amendment, and a corresponding check for \$110.00 is enclosed. If, there are additional fees due, Applicant requests that this paper constitutes any necessary petition and authorizes the Commissioner to charge any underpayment, or credit any overpayment, to Deposit Account No. 23-1925

If the examiner finds that there are any outstanding issues which may be resolved by a telephone interview, the Examiner is invited to contact the undersigned at the below listed number

Respectfully submitted,

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